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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,273	02/01/2001	Frank M. Sexton	103	7225

7590 12/01/2006

Joseph H. Golant
Suite 3500
77 West Wacker Drive
Chicago, IL 60601-1692

EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,273

Applicant(s)

SEXTON ET AL.

Examiner

Vivek D. Koppikar

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3626

DETAILED ACTION

Status of the Application

1. Claims 1, 3, 5-7, 9 and 12 have been examined in this application. This is a Final Office Action in response to the "Amendments" and "Remarks" filed on September 29, 2006. No additional Information Disclosure Statements (IDS) have been filed in this case.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-7, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,752,236 to Sexton in view of "Auto-Homeowners packages look like a winner" by Thomas McCoy (hereinafter referred to as McCoy), US Patent Application Publication 2002/0072936 to Newman and in further view of US Patent Number 6,912,502 to Buddle.

(A) As per claims 1 and 5, As to claims 1 and 5, Sexton discloses a method for forming an insurance plan comprising the steps of:

collecting data concerning multiple insurance coverages from among at least three coverages. (Sexton: Col. 8, 54-62; Col. 9, Ln. 1-10; Col. 10, Ln. 10-21 and Col. 17, Ln. 48-60). (Note: The examiner takes the position that Sexton relates to prototype or tentative insurance contracts in that the insured in Sexton are inputting data in an attempt to receive a quote of an estimated premium for a prospective (tentative) insurance policy (Sexton: Col. 4, Ln. 16-39).

Art Unit: 3626

inputting said data concerning multiple insurance coverages into a data processing apparatus (Sexton: Col. 13, lines 54-58);

collecting data about an individual or other risk to be insured (col.13, lines 62-66);

inputting said data individual related data or other risk into the data processing apparatus (col. 13, lines 62-66) ;

disproportionately allocating benefits and obligations regarding said prototype contract into at least two new proposed insurance contracts, said at least two new contracts being separate but related (Sexton: Col. 10, lines 35-40 and lines 51-66 and col. 12, lines 18-64); and

displaying all of the qualified (e.g. qualified under regulatory requirements) separate but related policies (Sexton: Col. 5, Ln. 43-48 and Col. 13, lines 39-42).

Sexton does not explicitly disclose selecting either a property or casualty coverage to form a prototype policy, however, McCoy discloses selecting property and/or casualty coverages to form a prototype policy (i.e. package product)(abstract-- page 1, page 2, paragraph 7). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by McCoy within Sexton for the motivation of providing increased retention as well as lowering servicing costs since updating of policy information can be accomplished for several coverages at once (McCoy: Page 2, Paragraph 4). (Note: Even though McCoy does not relate to life or health insurance McCoy discloses a broader Universal Security Policy and at the time of the invention, one of ordinary skill in the insurance industry would have been motivated to increase the choices of the types of coverages offered by

Art Unit: 3626

Sexton with the choices offered in McCoy with the motivation of having a means of providing an insured with a policy providing greater security (more universal security) against more types of risks including losses from loss and/or damage of property in addition to costs or losses resulting from personal health conditions and another the motivation of combining these contracts would be to lower service costs as recited in McCoy (Page 2, Paragraph 4).)

Sexton in view of McCoy do not teach that the insurance policy concerns three of more of the following categories: life, health, disability, major medical, critical illness, and long-term care; however, this feature is taught in Newman (Sections [0011]-[0012] and [0021]—Sexton discloses three of these types of coverages from the aforementioned list)). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the combined method of Sexton in view of McCoy with the aforementioned feature from Newman with the motivation of providing insureds with a policy which provides various types of benefits including incidental expense benefits, supplemental benefits, and long term care benefits, as recited in Newman (Section [0009]).

Sexton in view of McCoy and Newman do not teach the step of testing the new proposed insurance contracts against regulatory requirements, however, this feature is taught by US Patent Number 6,912,502 to Buddle (Abstract and Claims). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Sexton in view of McCoy and Newman with the motivation of having a means to manage compliance issues, as recited in Buddle (Col. 1, Ln. 5-10; Field of the Invention).

Art Unit: 3626

(B) As per claims 3 and 7, Sexton discloses a method as claimed in claim 1 wherein the data about an individual to be insured includes information concerning one or more of the following subjects: sex, age, marital status, individual medical history, family medical history, usage of alcohol, tobacco and drugs, automobile driving record, credit report, financial statement, criminal record, current medical examination report and results and any physical disabilities and impairments (col. 13, lines 62-66).

(C) As per claim 6, Sexton discloses an insurance system as claimed in claim 5 wherein: base product data relates to the probability of the event insured against occurring, the time value of money, the benefits promised, expenses, and profits and contingencies (Col. 9, Ln. 1-10).

(D) As per claim 9, this claim is substantially similar to claim 3 and is therefore rejected on the same basis.

(E) As per claim 12, this claim is substantially similar to claim 1 and is therefore rejected in the same manner.

Response to Arguments

4. Applicant's arguments filed on September 29, 2006 have been fully considered but they are not persuasive. The applicants arguments will be addressed in sequential order as they were addressed in the "Remarks" section.

Applicants argue that the Sexton/Burkhalter reference has as inventors the same two people who are applicants in the instant application. However, it is not clear to the Examiner whether they applicants are trying to disqualify this reference as prior art. The Examiner would like to note that this patent was issued (and hence published) more than one year prior to the date that the applicants filed this instant application.

Art Unit: 3626

Applicants argue that Sexton does not teach using three or more coverages together, however, Sexton does in fact teach this very feature, as noted in the rejection of Claim 1, above (Sexton: Col. 10, Ln. 58-62 and Col. 17, Ln. 54-60).

In response to applicant's argument that there is no "motivation" to combine McCoy with Sexton, except for the teachings of the application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Examiner's Suggestions

5. The prior art of record does not disclose an actual formula or numerical relationship which expresses the precise manner in which three or more types of coverages are disproportionately allocated among at least two separate but related contracts. The Examiner recommends claiming an actual formula or numerical relationship which will precisely describe the disproportionate allocation step in more detail. However, the applicant should be aware that any amendments to the claims must have support in the specification. Moreover, any amendments to the claims will be subject to an updated prior art search before allowance of the claims can be considered.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3626

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3626

Sincerely,



Vivek Koppikar

11/21/2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER